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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------|
| 10/656,070 | 09/05/2003 | David Charles Lyons | 12929.1062USCI | 8343 |
| 23552 | 7590 | 11/03/2005 | | |
| MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903 | | | EXAMINER COCKS, JOSIAH C | |
| | | | ART UNIT 3749 | PAPER NUMBER |

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/656,070 | LYONS ET AL. |
| | Examiner Josiah Cocks | Art Unit 3749 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 October 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 33-35, 46-48, 50, 52, 53 and 55-58 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 33-35, 46-48, 50 and 52 is/are allowed.
- 6) Claim(s) 53 and 56-58 is/are rejected.
- 7) Claim(s) 55 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Receipt of applicant's After Final amendment filed 10/4/2005 is acknowledged. By this amendment applicant has amended the claims 48 and 53 to incorporate limitations of dependent claims that the examiner previously indicted would be allowable. However, newly discovered reference, U.S. Patent No. 4,242,398 to Segawa et al., is applied in the rejection of claims 53 and 56-58. The statement of the grounds of the rejection follow. As the references noted below were not previously applied to applicant's claims, this action is made non-final.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 53, 56, and 58 are rejected under 35 U.S.C. 102(b) as being anticipate by U.S. Patent No. 4,242,398 to Segawa et al. ("Segawa").

Segawa discloses in the specification and figures 1 and 2 the invention as described in applicant's claims 53, 56, and 58. In particular, Segawa shows a method for forming a panel comprising the steps of: providing a mold (see at least col. 11, lines 31-33); providing an inorganic fiber to the mold, and specifically the mold cavity (see at least col. 3, line 24); compressing the inorganic fiber within the mold (see at least col. 11, lines 55-60); forming at

least one cavity in a bottom surface of the panel (see panel 1 with raised cavities 2); where at least one cavity extends at least a portion of a top surface of the panel (See Fig. 2); and heating the mold (see at least col. 11, lines 29-43).

Segawa also shows providing a binder to the mold (see col. 3, lines 50-68).

In regard to the recitation that the panel is “for use in a gas fire place burner”, this is regarded as merely a statement of intended use. It has been held that if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999); see also MPEP 2111.02. Further, in a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the panel formed in Segawa would be capable of functioning in a gas fireplace and such use does not result in a manipulative difference. Accordingly, this statement in the preamble of the claim is not given any patentable weight.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Segawa as applied to claim 54 above in view of U.S. Patent No. 5,738,818 to Atmur et al. ("Atmur").
Segawa teaches the use of "ordinary molds" for forming the panel (1) with raised cavities (2) (see col. 11, lines 67-68). However, Segawa does not disclose explicitly the use of male and female dies to form the cavities.

Atmur teaches a molding process that is the same field of endeavor as both Segawa and applicant's invention. In Atmur, a fiber reinforced material undergoing compression molding has cavities formed through the use of male (14) and female dies (12) (see at least col. 6, lines 37-48).

Therefore, in regard to claim 57, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to mold the cavities of Segawa so as to be formed through the use of male and female dies as taught in Atmur as these dies are understood in the art

of forming fiber refractory bodies to desirably produce a cavity structure in a plate or panel (see Atmur, at least col. 6, lines 37-67).

Allowable Subject Matter

7. Claims 33-35, 46-48, 50, and 52 are allowable.
8. Claim 55 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. The following is a statement of reasons for the indication of allowable subject matter:

In regard to claims 33-35, 46, and 47, the prior art does not teach or suggest the invention of gas burner for a fireplace having the particular combination of structural elements as recited in these claims.

In regard to claim 48, 50 and 52 the prior art does not teach or suggest the method for forming a gas burner for a fireplace as recited in claim 48 that includes the particular steps of forming a compression molded panel with inorganic fiber, forming the particular cavity in the panel as recited, and coupling a burner member to the panel to produce the gas burner.

In regard to claim 55, the prior art does not teach or suggest the method for forming panel as recited in independent claim 53 in conjunction with the step of forming a prefabricated log in a portion of the panel as further recited in claim 55.

Conclusion

10. The references relied upon in this rejection were not previously of record. Accordingly this action is made non-final. A THREE (3) MONTH shortened statutory period for reply has been set. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Josiah Cocks whose telephone number is (571) 272-4874. The examiner can normally be reached on weekdays from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg, can be reached at (571) 272-4828. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://portal.uspto.gov/external/portal/pair>. Any questions on access to the Private PAIR system should be directed to the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

jcc
October 28, 2005



JOSIAH COCKS
PRIMARY EXAMINER
ART UNIT 3749